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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,844	11/23/1998	GAD JANAY	030	1758

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EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/197,844

Examiner

CESAR B PAULA

Applicant(s)

JANAY, GAD

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the RCE filed on 6/19/2003.

This action is made Non-Final.

2. In the amendment, claims 1-18 are pending in the case. Claims 5, 10-11, and 15 are independent claims.

3. The rejections of claims 1-3, 5-11, and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Corona et al, hereinafter Corona (Pat.# 5,316,279, 5/31/94), in view of Barnes, "10 Minute Guide To Windows 3.1", SAMS, 1992, p.119-123, and further in view of Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95) have been withdrawn as necessitated by the amendment.

4. The rejections of claims 4, and 12 under 35 U.S.C. 103(a) as being unpatentable over Corona, in view of Barnes, and further in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97) have been withdrawn as necessitated by the amendment.

5. The rejections of claims 15-18 under 35 U.S.C. 103(a) as being unpatentable over Corona, and further in view of Warmus have been withdrawn as necessitated by the amendment.

Drawings

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95), in view of Barnes, "10 Minute Guide To Windows 3.1", SAMS, 1992, p.119-123.

Regarding independent claim 1, Warmus discloses automatically intercepting a print job sent to a printer and adding additional variable information, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template (c.3, L.8-67, c.5, L.61-c.7, L.67). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above

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a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs.

Furthermore, Warmus teaches the printing of additional information related to a print job. The additional information is retrieved from a database using the variable data in the templates for retrieving additional information from the database or as a key for the database (c.3, L.8-67, c.5, L.61-c.6, L.67).

Regarding claim 2, which depends on claims 1, Warmus teaches the printing of various books or book versions from the same single print job (col.7, lines 37-67).

Regarding claim 3, which depends on claims 1, Warmus teaches the printing of various books or book versions containing different or variable information which changes from book to book (col.7, lines 40-67).

Claims 5-6 are directed towards a tool for implementing the tool of claims 1-2, and therefore are similarly rejected.

Regarding claim 7, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information in a double-side printing format (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67).

Claims 8-10, and 13-14 are directed towards a formatting tool for implementing the tool of claims 3, 3, and (1 & 3), 1, and 3, and therefore are similarly rejected.

Regarding independent claim 11, Warmus discloses automatically intercepting a print job, with static, and variable information—*first, and second portion*-- sent to a printer and adding additional variable information from a database based upon the variable information or *keys*, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template. One document having information not present in the other (c.3, L.8-67, c.5, L.61-c.7, L.67).

Regarding independent claim 15, Warmus teaches the printing of various books or book versions using template files, which have fixed data, and information for identifying locations for printing variable information (col.,6, lines 1-67, col.7, lines 37-67).

Moreover, Warmus teaches the formatting and interception of data before it reaches the printer, and inserting variable data located in a database (col.5, lines 60- col.6, line 67). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print

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jobs.

Furthermore, Warmus fails to explicitly disclose *parsing the identification segment*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have parsed to identify the segment, because Warmus teaches the reading of variable template data to identify where to retrieve, and how to format the variable data (col. 6, lines 1-col.7, line 67).

Claims 16-18 are directed towards a method for implementing the tool of claims 2, 2, and 3, and therefore are similarly rejected.

9. Claims 4, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Barnes, and further in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

Regarding claim 4, which depends on claim 3, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose *whether or not information is confidential*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of

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Warmus, Barnes, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 12, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose fails to explicitly disclose *second portion is a confidential portion*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Response to Arguments

10. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "With the present invention, the software application that sends the original document/data to the print tool can work as usual without knowing the index key system of the database or any processing of the data after it is sent to the print spool...." page 6, lines

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16-21) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant submits that the cited art of record fails to make the claimed features as newly claimed obvious (page 7, lines 16-19). The Applicant is referred to the rejection of the newly amended claims in view of the newly amended claims.

Further, the Applicant submits that neither Corona, Ikenoue, nor Warmus teach a print spooler (page 7, lines 23-24). While this is true, Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120).

Moreover, the Applicant states that there is no inherent need in Corona, or Ikenoue to intercept data from the print spool so as to obtain to obtain additional information from the database (page 8, lines 10-11, 22-23). The Applicant is referred to the rejection of the newly amended claims in view of the newly amended claims.

Moreover, the Applicant states that there is no inherent need in Warmus to intercept data from the print spool so as to obtain to obtain additional information from the database (page 9, lines 8-9). The Examiner disagrees, because Warmus discloses automatically intercepting a print job sent to a printer and adding additional variable information, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template (c.3, L.8-67, c.5, L.61-c.7, L.67). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at

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the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs.

Moreover, the Applicant states that none of the cited references teach the use of intercepted data from the print spool as an index to access the database (page 10, lines 10-12). The Examiner disagrees, as explained above Warmus teaches the intercepting of data sent to a printer for printing additional variable data.

Regarding claims 1, and 5, the Applicant states that none of the cited references teach the printing of a document in a format different from that received by the print spool (page 10, lines 14-20). The Examiner disagrees, as explained above Warmus teaches the intercepting of data sent to a printer for printing additional variable data—format different from the data format sent to the printer.

Regarding claim 11, the Applicant states that none of the references teaches that only a portion of the original data is included in one document, but not in the other (page 11, lines 4-14). The Examiner disagrees, because Warmus discloses automatically intercepting a print job, with static, and variable information—*first, and second portion*-- sent to a printer and adding additional variable information from a database based upon the variable information or *keys*, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template. One document having information not present in the other (c.3, L.8-67, c.5, L.61-c.7, L.67).

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Claims 2-4, 6-9, 12-14, and 16-18 are rejected at least based upon their dependency on independent claims 1, 5, 10-11, and 15.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label **“PROPOSED”** or **“DRAFT”**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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A handwritten signature in black ink, appearing to read "Cesar B Paula". The signature is fluid and cursive, with the first name "Cesar" and last name "Paula" being more prominent than the middle initial "B".

CESAR B PAULA

Patent Examiner

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